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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,077	08/07/2003	Gary K. John	1095	9844

7590
Donald J. Ersler
725 Garvens Avenue
Brookfield, WI 53005

01/24/2007

EXAMINER

LAUX, JESSICA L

ART UNIT

PAPER NUMBER

3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/636,077	Applicant(s) JOHN, GARY K.	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-21 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8-10,13 and 15 is/are rejected.
- 7) ☒ Claim(s) 3,4,11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 11/14/2006. Accordingly claims 1, 9, and 16 have been amended. Claims 1 and 9 remain withdrawn as being drawn to a non-elected invention with no generic or linking claim being allowable.

Claims 2 and 10, indicated as allowable in the previous Office Action, are now rejected. Therefore this Action is Non-Final.

Election/Restrictions

Claim 16 is allowable. The restriction requirement between species I, II, III and IV, as set forth in the Office action mailed on 09/28/2006, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim 21, directed to species IV is no longer withdrawn from consideration because the claim requires all the limitations of an allowable claim. However, claims 7 and 14, directed to species IV remain withdrawn from consideration because they do not require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

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Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Response to Arguments

Applicant's arguments filed 11/14/2006 have been fully considered but they are not persuasive.

Applicant argues that Sayer "does not disclose, teach or suggest the insertion of a seal between the ends of two adjacent frame members" and that the rigid corner gusset of Sayer "does not create a seal".

Examiner disagrees. The rigid corner gusset of Sayer does create a seal by the fact that it provides a tight and secure closure that prevents the members from separating thereby sealing them together. Further the "seal" of Sayer is between the ends of the two adjacent frame members as evidenced by the drawings. The fact that the gusset is inserted into the inner cavities of the frame members does not preclude it from being between the frame members. The gusset is therefore into and between the frame members.

Applicant further states that Sayer does not disclose "applying a sealing strip to an outside perimeter of the at least four frame members", but applicant has merely stated this without further explanation or arguments regarding this allegation.

Therefore, examiner directs applicant's attention to the previous Office Action where it is clearly explained that Sayer does indeed apply a sealing strip to an outside perimeter o

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the at least four frame members (Col. 2, lines 61-63; and figure 2 which depicts groove 38 extending around the perimeter of the frame).

Further still, applicant states that Sayer does not disclose "a draw member that secures the ends of the two adjacent frame to each other". Again applicant has merely stated this without further explanation of arguments regarding this allegation, and so again examiner directs applicant's attention to the previous Office Action where it is clearly explained that Sayer does indeed disclose a draw member that secures the ends of the two adjacent frame members to each other (reference Col. 4, lines 3-6 and elements 102, 104, 106, 108).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-6, 8-9, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sayer (4831804).

Regarding claim 1: Sayer discloses a method of forming a removable window insulator, comprising the steps of: providing at least four frame members (Sayer discloses four frame members, Col. 2, lines 39-40, so there is an inherent step of providing the four frame members); mitering each end of the at least one of said at least four frame members (where figures 1-3 disclose the ends of the members being mitered, so there is an inherent step of mitering the ends); inserting a compressible seal (where element 60 seals the members together and is compressible as every material is inherently compressible under a certain pressure) between the ends of two adjacent frame members before securing said two adjacent frame members to each other (where

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the securing means comprises inserting screws, figure 3, and it is inherent that member 60 is inserted before securing the two frame members as the screws penetrate the sealing member 60); sealing at least one pane (20) to an inside edge perimeter of said at least four frame members (where the sealing material is 110, figure 4 and Col 3, lines 45-54); and applying a sealing strip to an outside edge of said at least four frame members (where Sayer discloses in Col. 2, lines 60-63 that grooves are designed to receive insulating material, which is a sealing member, so there is an inherent step of applying the sealing strip).

Regarding claim 5: The method of forming a removable window insulator of claim 1, further comprising the step of: securing said two adjacent frame members to each other with a draw member (102, 104, 106, 108; Col. 4, lines 3-6).

Regarding claim 6: The method of forming a removable window insulator of claim 1, further comprising the steps of: applying a top seal strip (110) to a front peripheral edge of each one of said at least one pane; and applying a bottom seal strip (26) to a bottom peripheral edge of each one of said at least one pane (figure 4, where 26 bears on a bottom peripheral edge of the pane at the bottom member of the frame).

Regarding claim 8: The method of forming a removable window insulator of claim 1, further comprising the steps of: adjusting at least one said draw member to fit said removable window insulator into a window frame (i.e. screwing the draw member, as above, all the way in so that it does not protrude, therefore allowing the window insulator to fit into a window frame).

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Regarding claim 9: Sayer discloses a method of forming a removable window insulator, comprising the steps of: providing at least four frame members (Sayer discloses four frame members, Col. 2, lines 39-40, so there is an inherent step of providing the four frame members); mitering each end of the at least one of said at least four frame members (where figures 1-3 disclose the ends of the members being mitered, so there is an inherent step of mitering the ends); inserting a compressible seal (where element 60 seals the members together and is compressible as every material is inherently compressible under a certain pressure) between the ends of two adjacent frame members before securing said two adjacent frame members to each other with a draw member (102, 104, 106, 108; Col. 4, lines 3-6, it is inherent that member 60 is inserted before the frame members are secured as the screws penetrate the sealing member 60); sealing at least one pane (20) to an inside edge perimeter of said at least four frame members (where the sealing material is 110, figure 4 and Col 3, lines 45-54); and applying a sealing strip to an outside edge of said at least four frame members (where Sayer discloses in Col. 2, lines 60-63 that grooves are designed to receive insulating material, which is a sealing member, so there is an inherent step of applying the sealing strip).

Regarding claim 13: The method of forming a removable window insulator of claim 9, further comprising the steps of: applying a top seal strip (110) to a front peripheral edge of each one of said at least one pane; and applying a bottom seal strip (26) to a bottom peripheral edge of each one of said at least one pane (figure 4, where 26 bears on a bottom peripheral edge of the pane at the bottom member of the frame).

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Regarding claim 15: The method of forming a removable window insulator of claim 9, further comprising the steps of: adjusting at least one said draw member to fit said removable window insulator into a window frame (i.e. screwing the draw member, as above, all the way in so that it does not protrude, therefore allowing the window insulator to fit into a window frame).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayer (4831804) in view of Johnston et al (4199900).

Regarding claims 2 and 10: Sayer discloses the method of forming a removable window insulator as in claims 1 and 9 above, but does not expressly disclose at least one cross member within said inside edge perimeter of the frame members.

Johnston et al. discloses a window insulator comprising four frame members and a cross member (30) located within the inside edge perimeter of the frame members (figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the window insulator of Sayer to have a cross member as disclosed by Johnston because the cross member provides support to the frame structure as well as provides an appealing appearance to the window.

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Allowable Subject Matter


Claims 3-4 and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16-21 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


JEANETTE E. CHAPMAN
PRIMARY EXAMINER
GROUP 3400

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JL
01/06/2007